

REMARKS

1. (amendments to the claims) Claim 1 has been amended to substantially incorporate the subject matter of claims 31, 33, and 36-39. Claims 31, 33, and 36-39 have been correspondingly canceled. Claims 32, 34, 35, 40, 41, and 44 have been amended to reflect their changed dependencies. Claims 1, 24, 26-30, 32, 34, 35, and 40-49 are now pending.

2. (specification) In the Action mailed May 13, 2008, the Examiner objects to the title and the disclosure. Applicant has amended the title and disclosure as suggested by the Examiner and submits that the specification rejections have been overcome. Applicant has also amended the Abstract for added clarity.

3. (claim rejections – 35 USC § 102) In the Action, the Examiner rejects claims 1, 24, 27-38, 40-45, 47 and 49 under 35 USC § 102(b) as being anticipated by U.S. Pat. No. 3,752,161 to Bent. Without agreeing or disagreeing with the Examiner, Applicant notes that claim 1 has been amended to incorporate the subject matter of claims 31, 33, and 36-39. Given that claim 39 has not been rejected under 35 USC § 102, and that all remaining pending claims directly or indirectly depend on claim 1, Applicant submits that the amendments to claim 1 have rendered the Examiner's 35 USC § 102 rejection moot.

4. (claim rejections – 35 USC § 103) Given that the Applicant has amended claim 1 to incorporate the subject matter of claims 31, 33, and 36-39 and in view of the fact that canceled claim 39 depended on claims 1, 36, 37 and 38, Applicant will now address the Examiner's rejection of claim 39 under 35 USC § 103, see section 7 of the Action mailed May 13, 2008. In such rejection, the Examiner opines that claim 39 should be rejected under 35 USC § 103(a) in view of a combination between Bent, cited above, and U.S. Pat. No. 2,625,682 to Cristiano. The Applicant disagrees. The reasons behind such disagreement are presented in the following four paragraphs.

4A. (nonanalogous art) According to MPEP 2141.01(a) I, “[t]he examiner must determine what is ‘analogous prior art’ for the purpose of analyzing the obviousness of the subject matter at issue. Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*” (emphasis added). Therefore, even after KSR, the “need” required for the combination must be addressed in Bent. However, in section 7 of the Action mailed May 13, 2008, the Examiner does not address such need. The Examiner only states i) that “Bent [does] not specifically [teach] a motion transmission member that is a lever”, which statement is not a “need” and is just an assertion that Bent does not teach a feature of the claim at issue, and ii) that “substitution of one motion transmission member for another would have yielded predictable results, namely to transfer the movement from the piston to another element”, which statement already relies on the presence of Cristiano and does not address to which “need” of Bent Cristiano obviates to justify its choice by the Examiner.

Frankly speaking, it is the Applicant’s opinion that a person skilled in the art of surgical tools for gripping, cutting or perforating bone, tissue or other structures (see Bent’s Abstract) would be hardly pressed to look for improvements in the field of stapling mechanisms. The Examiner should note that both the surgical device of Bent and the surgical device of the present disclosure are not stitching devices for surgery. In any case, as clearly taught by *KSR International Co. v. Teleflex Inc* mentioned above, a “need” must be present in Bent, and such “need” has not been shown by the Examiner.

4B. (prima facie case under 35 USC §103) Amended claim 1 recites that the “*piston is coupled to [the] slidable blade by interposition of a motion transmission member.*” While Applicant agrees with the Examiner that Bent comprises a piston (104) (receiving a stem (102)) and a slidable blade (20), Applicant does not understand why the Examiner believes (see section 4c of the Action) that element (100) in Bent is a “*motion transmission member*” coupling the piston (104) to the blade (20). Element (100) in Bent

is just another piston which shares the same stem (102) of piston (104). See column 5, line 58 through column 6, line 18 in Bent. In other words, stem (102) goes, during operation, in direct contact with element (20) as shown in Fig. 1 in Bent, where it is shown how stem (102) contacts portion (40), which is “the rearward section . . . of member (20)” as mentioned at column 4, line 21 of Bent. The presence of additional pistons serves only to increase the total area exposed to gases in Bent, as discussed at column 6, lines 19-30 of Bent. Therefore, Applicant submits that no “*motion transmission member*” is interposed between the stem (102) and the slidable blade (20) in Bent.

4C. (MPEP 2143.01) In section 7 of the Action, the Examiner notes that Cristiano teaches a motion transmission member that is a lever (16) attached to a piston (128) and that it would have been obvious to substitute the motion transmission member of Bent with the motion transmission member of Cristiano, because such substitution would have yielded predictable results. While Applicant agrees with the Examiner that Cristiano teaches a lever attached to a piston, Applicant would also like to point out that there is no hint of how a substitution should be done. For example: 1) which piston in Belt should be replaced with Cristiano’s piston+lever? Piston (100) or Piston (104)? 2) How is this possible, in Belt, to replace a piston and not the other if they both share the same stem (102)? Any change above would clearly change the principle of operation of Bent.

Moreover, any change would clearly render Bent inoperable for its intended purpose (see MPEP 2143.01) because, looking at Fig. 1 of Bent, stem (102) and blade (20) are aligned so that movement to the left/right of stem (102) advances/retracts blade (20) along the same line of stem (102). On the other hand, the arrangement of Cristiano is intended to connect motion of two arrangements (piston (128) and vertical arrangement (56) moving along non-collinear trajectories). Therefore, insertion of the Cristiano arrangement into Bent would destroy co-linearity between stem (102) and blade (20) in Bent.

4D. (prima facie case under 35 USC § 103(a)) Even assuming, *arguendo*, that Cristiano's lever+piston can be inserted into Bent's surgical device, where is the hint to the person skilled in the art to put the lever (and not the piston) on the side of the slidable blade?

In view of the above four arguments, Applicant submits that claim 1 is patentable under 35 USC 103(a), together with the remaining claims, at least by virtue of their direct or indirect dependency on claim 1.

5. (fees) The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-4194. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection herewith may be charged to deposit account no. 50-4194.

I hereby certify that this correspondence
is being electronically transmitted on

August 12, 2008
(date of deposit)

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Respectfully submitted,

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